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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,184	04/15/2004	Michael D. Bonneau	BON-005	9806

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/826,184

Applicant(s)

BONNEAU, MICHAEL D.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,11,12,14-20,28,30,32,33,36 and 41-56 is/are rejected.
- 7) ☒ Claim(s) 7,10,13,21-27,29,31,34,35 and 37-40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/9/04; 2/9/05</u> | 6) <input checked="" type="checkbox"/> Other: <u>Sample TD and \$3.73</u>               |

### DETAILED ACTION

This Office action is responsive to communication received 04/15/2004 – application papers filed; 06/18/2004 – Oath; 07/06/2004 – Response to Notice to File Missing Parts; 07/09/2004 – IDS; 02/09/2005 – IDS.

Claims 1-56 are pending.

Following is an action on the MERITS:

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 8, 9, 11, 12, 14, 15, 16, 17, 18, 19, 20, 28, 30, 32, 33, 36 and 41-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending U.S. Patent Application No. 11/317,650. This is a provisional double-patenting rejection, as the conflicting claims have not yet been patented.

For double patenting to exist as between the rejected claims and claims 1-22 of the copending application, it must be determined that the rejected claims are not patentably distinct from claims 1-22. In order to make this determination, it first must be determined whether there are any differences between the rejected claims and claims 1-22 and, if so, whether those differences render the claims patentably distinct.

Instant claim 1 requires a main body frame, a first weighting member and a second weighting member. Instant claim 41 similarly requires a main body and first and second weighting members, wherein the main body further includes a milled out front portion and a milled out portion beneath the top surface. Last, instant claim 50 includes a main body, a first weighting member and a second weighting member.

It is clear that all the elements of claims 1, 41 and 50 are to be found in copending claims 1-22. The difference between the instant claims and copending claims 1-22 lies in the fact that the copending claims 1-22 include many more elements and are thus much more specific. Thus the invention of claims 1-22 of the copending application is in effect a "species" of the "generic" invention of claims 1-6, 8, 9, 11, 12, 14, 15, 16, 17, 18, 19, 20, 28, 30, 32, 33, 36 and 41-56. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since instant claims 1-6, 8, 9, 11, 12, 14, 15, 16, 17, 18, 19, 20, 28, 33, 36 and 41-56 are anticipated by claims 1-22 of the patent, these instant claims are not patentably distinct from copending claims 1-22.

As to claims 2-6, 8, 9, 11, 12, 14, 15, 16, 42-49 and 51-56 and with respect to the limitations relating to the weight and/or density comparisons of the respective main body, first weight and second weight, one with the other, these limitations are deemed to be obvious design variations over the weight and density limitations found in copending claims 2-4 and 14-19.

As to instant claims 17, 18, 19, see claims 5, 6, and 7, respectively, of the copending application.

As to claim 30, the skilled artisan would have found it obvious to fixedly secure the mating parts of the claimed device of the copending '650 application using any one of a number of common mechanical expedients. The claimed "screws" of the instant application are deemed to be an example of said common mechanical expedients.

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As to instant claims 20, 28, 32, 33 and 36, these limitations are inherently present in the structure included in claims 1-22 of the copending application.

***Allowable Subject Matter***

Claims 7, 10, 13, 21, 22, 23, 24, 25, 26, 27, 29, 31, 34, 35 and 37-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Terminal Disclaimer***

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome a provisional obviousness-type double patenting rejection over a pending application (37 CFR 1.321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel\_\_\_\_, Frame\_\_\_\_" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:\_\_\_\_\_ To:\_\_\_\_\_" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an

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application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

### ***Further Prior art of Record***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See insert (13) in Figure 7 of Hamilton. Figure 5 in Kershaw shows a cavity just below the top surface. Tang shows a putter head design in Figure 3, of interest. Note Figures 9 and 10 in Grace. Holland, Spiker and MacIntyre show adjustable putter-style club heads.

### ***Comments on IDS***

The IDS received 02/09/2005 repeats a number of prior art citations, when compared to the IDS of 07/09/2004. In order to prevent any duplicate printing of the IDS documents, those references that are listed on both IDS documents have been lined-through on the later received IDS, dated 02/09/2005.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp  
April 13, 2006

  
**Sebastiano Passaniti**  
Primary Examiner